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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,368	02/10/2004	Edward J. Stashluk JR.	067439.0161	9915

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EXAMINER	
NGUYEN, THUY-VI THI	
ART UNIT	PAPER NUMBER
3689	

NOTIFICATION DATE	DELIVERY MODE
04/07/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/775,368	STASHLUK ET AL.	
	Examiner	Art Unit	
	THUY-VI NGUYEN	3689	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 March 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): 35 USC 112 rejection 1-5; 7-22, 24-28, 30-38.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1-5,7-22,24-28 and 30-38*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☒ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). 03/17/11

13. ☐ Other: _____.

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689

/T. N./
Examiner, Art Unit 3689

Continuation of 11. does NOT place the application in condition for allowance because:
The amendment overcomes the 112 rejection. However, the art rejections of claims 1-5, 7-22, 24-28 and 30-38 are respectfully maintained.

With respect to Applicant's argument on pages 16-17, Applicant stated that the neither Tsunenari nor Savino discloses a return shipping label that "complies with shipping label specifications of the choice of carrier" and includes both "the first machine readable code not associated with the carrier" and "a second carrier-specified machine readable code also present on the shipping label" as recited in claim 1. However this is not persuasive.

The reference of Tsunenari par. 0081, figure 10i discloses "the shipping label 1029 is in the format of the specific carrier that will do the transporting. The label 1029 includes the sender's address 1029a; the destination address 1029b; the weight of the parcel 1029c and information 1029d in the machine readable bar code used by the carrier for the pick-up and tracking of the parcel". Thus, Tsunenari discloses the shipping label complies with specifications of choice of carrier and the shipping label includes a machine readable code (interpreted to be a second machine readable code) that is used by the carrier.

The reference of Savino is used to teach shipping label contains a machine readable code (interpreted to be a first machine readable code and not associated with the carrier) that represents the shipping information and identification transaction for coordinating shipping and receiving information between supplier and customer in order to reduce the time consuming and costly (see Savino 4-5, at least col. 2, lines 7-19; col. 3, lines 34-54; col. 4, lines 24-35).

Therefore, it would have been obvious to one of ordinary skill in the art to provide the shipping label contains the readable bar code used by the carrier of TSUNENARI to include a machine readable code that represents shipping information and identification transaction as taught by SAVINO since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately e.g. putting both of the readable bar codes in the same shipping label, the content or functionality of the bar codes will not change. One of ordinary skill in the art have recognized the knowledge of putting the two readable codes together e.g. giving the well known nature of document creation software and printer driver software to achieve the combination of the two codes in the same shipping label would have been predictable.

Therefore the combination of Tsunenari and Savino discloses a return shipping label that "complies with shipping label specifications of the choice of carrier" and includes both "the first machine readable code not associated with the carrier" and "a second carrier-specified machine readable code also present on the shipping label" as recited in claim 1 (See the office action mailed on 01/20/11 for further details).

Applicant's statement on page 17 of the remark indicates that the claims recite "using the computer....to generate a machine readable code for the return shipping label for shipment from the customer to the return center" to show the specific structure and functional distinction between the claimed "shipping label" and the labels disclosed in Tsunenari and Savino. However, this is not persuasive because "the return shipping label for shipment from the customer to the return center" is considered as intended use limitation and does not provide the distinction structure and functional between the claimed "shipping label" and the label disclosed in Tsunenari and Savino. For example the claimed invention does not specify of how the shipping label is used e.g. how the shipping label is attached to the container, box or merchandise or what usual features of a shipping label is distinguish with the shipping label in combination of TSUNENARI and SAVINO. For the sake of an argument, assuming the shipping label in SAVINO is a not a shipping label according to the Applicant's assertion, the term "shipping label" in SAVINO is still broadly read over the "shipping label" as claimed because SAVINO clearly identifies "the shipping label contains a bar code for coordinating shipping and receiving information between customer and supplier" as shown in col. 1, lines 59-67; col. 2, lines 1-19.

In response to Applicant's argument on page 17of the remark, Applicant stated that SAVINO teaches a way from a shipping label that includes more than one bar code since SAVINO only discloses a shipping label that includes a single bar code. However, this is not persuasive as it is indicated in the office action. (See the office action mailed on 01/20/11 for further details).

In response to Applicant's argument on page 19 about the official notice "shipping origin information is well known to be included in the shipping label", Applicant traverse this finding is inadequate because Applicant did not provide why the notice fact "shipping label is include the shipping origin information e.g. return address" is not considered to be common knowledge or well known in the art. See MPEP 2144.03. (See the office action mailed on 01/20/11 for further details).

Noted: Independent claim has been amened. It is not an original claim as indicated "previously presented".

Noted: IDS as filed on 03/17/11 is not considered because it does not comply with 37.CFR 1.97 (d) and (e). Specifically, there is no statement as specified paragraph (e).